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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,528

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David J. Paul

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Law Office of Alan W. Cannon  
942 Mesa Oak Court  
Sunnyvale, CA 94086

EXAMINER

MAI, HAO D

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

06/07/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,528	<b>Applicant(s)</b> PAUL ET AL.	
	<b>Examiner</b> HAO D. MAI	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 128-137 and 145-151 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 128-137, 145-151 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed 03/26/2010 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/12/2010 has been entered.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

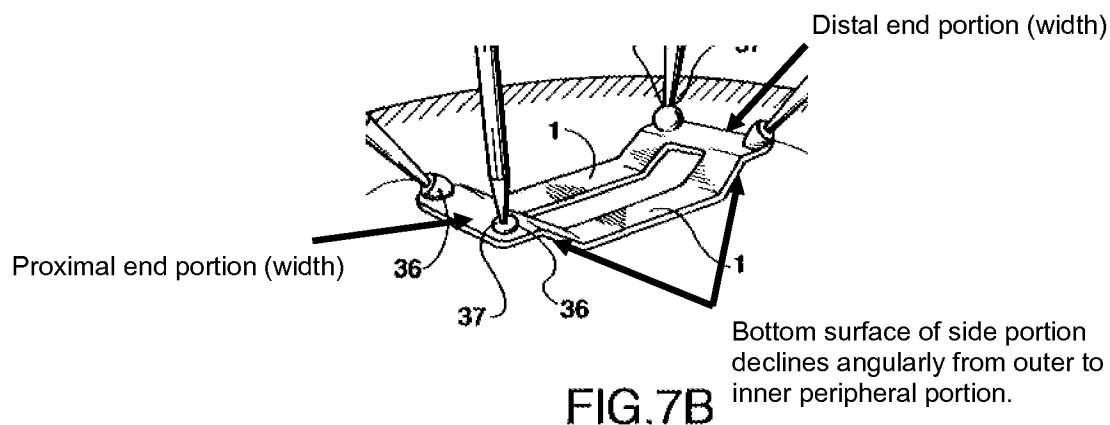
3. **Claims 128-133, 145, and 147-149, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (6,036,641).**

**Regarding claims 128**, Taylor et al. disclose a device 1 (Fig. 9A) capable of providing additional stabilization to tissue already in contact with a primary stabilization member, the device comprising: a single, substantially rigid tissue contact member 1 formed as a unitary U-shaped loop capable of being placed on the tissue; a connecting member/handle integrally formed with and extending from the tissue contact member and capable of being hand held or fixed to a relatively immovable object; and a lumen 48 in fluid communication with said contact member 1 (Fig. 9A).

As to the claimed shape of continuous loop, such continuous loop shape is well known in the surgical field. For example, in the embodiments of Figures 7B and 8, Taylor et al. show a contact member in the shape of a continuous loop. The continuous loop-shaped contact

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member shown in Figure 7B is also shown having proximal and distal end portions (width), and side portions 1 (length) extending between the proximal and distal end portion; wherein the length is greater than width. The contact member further has a bottom contact surface that declines angularly from outer peripheral portions of the portions of the contact surface included in said side portions 1 to inner peripheral portions of the portions of the contact surface in said side portions (see annotated Figure 7B below). Since such claimed continuous loop shape, dimensions, and angular bottom surface, are shown as known in the surgical field as shown by Figure 7B, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Figure 9A by making the contact member with such shape, dimensions, and angular bottom contact surface as shown by Figure 7B in order to establish an optimum contact between the contact member and the tissue. Furthermore, such modifications are merely changes in shape and configuration deemed as a matter of design choice well within the skill of a person in the art. MPEP 2144.04.



Note that the recitations "adapted to be placed on the tissue in an area bounded by primary tissue contact members" (claim 128 lines 7-8), and "such that the outer peripheral portions of the contact surface of said side portions are configured to contact the primary

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stabilization member while the inner peripheral portions of the contact surface of said side portions contact the tissue to provide additional stabilization of the tissue" (claim 128 lines 11-14), and similar recitations in other independent claims, are functional claim language or intended uses that does not provide structural limitations, but only functional limitations. If the prior art structure is capable of performing the recited functions or intended use, then it meets the claim. In this case, Taylor et al. show the contact member of Figure 9A in combination with the contact member of Figure 7B are capable of performing said claimed functional limitations.

**As to claims 129**, each of the embodiments of Figures 9A and 7B or the combination thereof has a base with central opening there through, capable of allowing access to a target site on the tissue. **As to claims 130-131**, the claimed substantially oval-shape would have been an obvious design choice well within the skill of a person in the art. MPEP § 2144.04. **As to claims 132-133**, Figure 9A shows the base member having a substantially hollow interior (defined by lumen 48 extending through the base member as shown in Fig. 9A) capable of developing a negative or positive pressure therein; and said lumen 48 is in fluid communication with said base member (column 17; lines 30-42).

**Regarding claims 145 and 147-149**, Taylor et al. disclose all the claimed elements as detailed above with respect to claims 128-133.

4. **Claim 134-137, 146, and 150-151, are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor et al. (6,036,641) in view of Borst et al. (5,836,311).**

**As to claim 134**, Taylor et al. disclose the invention substantially as claimed including openings 47 being fluidly connecting with said substantially hollow interior (lumen 48) and capable of applying a negative pressure to the tissue (column 17 lines 30-42). However, Taylor et al. fail to disclose such openings being at the bottom surface of the contact member. Borst et al. disclose a base member 81 having substantially hollow interior and integral suction

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ports/openings 82 at the bottom surface thereof; the hollow interior and the suction ports/openings 82 are capable of developing and applying a negative pressure to the tissue (Fig. 13; column 7 lines 18-41). Figure 13 also shows a connecting member/handle being fluidly connected to the hollow interior of base 81 and is capable of being connected to a source of negative pressure (column 7 lines 18-35). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Taylor et al. by placing such suction ports/openings at the bottom surface in order to provide a suction mechanism that suck onto or seal with the tissues, providing a more effective stabilization of the heart as explicitly taught by Borst et al.

**As to claims 135-137**, Taylor et al. in Figure 9A disclose the base member having openings 47 through an upper surface thereof (Fig. 9A column 17 lines 40-42), and the openings 47 being connected to two different lumens 48. However, Taylor et al. fail to teach a source of pressure that is independent from a pressure in the hollow interior of said base member. Borst et al. disclose two separate independent suction sources (column 7 lines 29-34). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Taylor et al. with two separate independent suction sources so that if one suction source were to lose contact with tissue, the other could still maintain capture as explicitly taught by Borst et al. (column 7 lines 29-34). Alternatively, one (negative) suction source can be used for adhering the contact member to the tissue as taught by Borst et al.; the other (negative or positive) suction source can be used for maintaining the surgical site clear and dry as taught by Taylor et al.

**Regarding claims 146 and 150-151**, Taylor et al. in combination with Borst et al. disclose all the claimed elements as detailed above.

***Response to Arguments***

5. Applicant's arguments regarding the amended claims have been fully considered but they are not persuasive and/or moot in view of the new ground(s) of rejection. Applicant's remarks are held to be responded to the above ground(s) of rejection.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO D. MAI whose telephone number is (571)270-3002. The examiner can normally be reached on Monday-Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/Hao D Mai/  
Examiner, Art Unit 3732**

**/Cris L. Rodriguez/  
Supervisory Patent Examiner, Art Unit 3732**